



Dkt. 1784/53661-AA/JPW/BJA/LCM

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Stewart Shuman and JoAnn Sekiguchi  
Serial No. : 10/666,486 Examiner: N. Bhat  
Filed : September 19, 2003 Art Unit: 1634  
For : TOPOISOMERASE-BASED REAGENTS AND METHODS FOR  
MOLECULAR CLONING

30 Rockefeller Plaza  
New York, New York 10112

Mail Stop AP  
Commissioner for Patents  
P.O. Box 1450  
Alexandria VA 22313-1450

Sir:

TERMINAL DISCLAIMER

Sloan-Kettering Institute for Cancer Research, ("Sloan-Kettering") of 1275 York Avenue, New York, NY 10021 is the assignee of record of the entire right, title, and interest in and to the above-identified application by virtue of an Assignment of rights in U.S. Serial No. 09/096,927, of which the above-identified is a continuation, which assignment was recorded with the U.S. Patent and Trademark Office on August 6, 1998 at Reel No. 9374, Frames 0348-0351, a copy of which is attached hereto, together with the Notice of Recordation, as Exhibit 1.

Sloan-Kettering is also the assignee of record of the entire right, title and interest in U.S. Patent No. 6,653,106, issued November 25, 2003 from the aforementioned U.S. Serial No. 09/096,927 by virtue of the same assignment attached hereto as Exhibit 1.

07/17/2009 EFLORES 00000019 10666486

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140.00 OP

Applicants : Stewart Shuman and JoAnn Sekiguchi  
Serial No. : 10/666,486  
Filed : September 19, 2003  
Page 2 of 3: Terminal Disclaimer

Sloan-Kettering hereby disclaims, except as provided below, the terminal portion of the statutory term of any patent granted on the subject application which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §154 to §156 and §173 of U.S. Patent No. 6,653,106 and hereby agrees that any patent issued from the subject application shall be enforceable only for and during such period that the legal title to such patent shall be the same as the legal title to U.S. Patent No. 6,653,106, this agreement to run with any patent granted on the subject application and to be binding upon the grantee, its successors and assigns.

In making the above disclaimer, Sloan-Kettering does not disclaim the terminal part of any patent granted on the subject application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §154 to §156 and §173 of U.S. Patent No. 6,653,106, in the event that such patent later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. §1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term.

I have reviewed the attached assignment and certify, to the best of my knowledge and belief, that Sloan-Kettering Institute for Cancer Research is the assignee of all right, title and interest in and to the subject application, and U.S. Patent No. 6,653,106. I further certify that I am authorized

Applicants : Stewart Shuman and JoAnn Sekiguchi  
Serial No. : 10/666,486  
Filed : September 19, 2003  
Page 3 of 3: Terminal Disclaimer

to sign this Terminal Disclaimer on behalf of Sloan-Kettering  
Institute for Cancer Research.

I hereby declare that all statements made herein of my own  
knowledge are true, and that all statements made on  
information and belief are believed to be true; and further  
that these statements were made with the knowledge that any  
such willful false statements and the like so made are  
punishable by fine or imprisonment, or both, under Section  
1001 of Title 18 of the United States Code and that any such  
willful false statement may jeopardize the validity of the  
application or any patent issued thereon.

Date: 06-14-09

Sloan-Kettering Institute for  
Cancer Research

By:



Eric M. Cottingham, Ph.D.  
Vice President, Research  
and Technology Management

# **EXHIBIT A**

**Applicants: Stewart Shuman and JoAnn Sekiguchi**

**Serial No.: 10/666,486**

**Filed: September 19, 2003**

# **EXHIBIT 1**

**Applicants: Stewart Shuman and JoAnn Sekiguchi**

**Serial No.: 10/666,486**

**Filed: September 19, 2003**



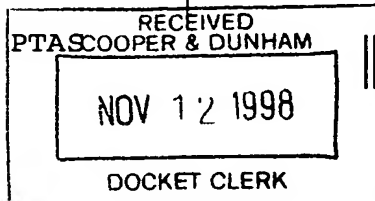
NOVEMBER 02, 1998

COOPER & DUNHAM LLP  
JOHN P. WHITE  
1185 AVENUE OF THE AMERICAS  
NEW YORK, NEW YORK 10036



*Jpw*  
**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
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\*100791652A\*

**UNITED STATES PATENT AND TRADEMARK OFFICE  
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PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 08/06/1998

REEL/FRAME: 9372/0348

NUMBER OF PAGES: 4

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

SHUMAN, STEWART

DOC DATE: 07/01/1998

ASSIGNOR:

SEKIGUCHI, JOANN

DOC DATE: 07/08/1998

ASSIGNEE:

SLOAN-KETTERING INSTITUTE FOR  
CANCER RESEARCH  
1275 YORK AVENUE  
NEW YORK, NEW YORK 10021

SERIAL NUMBER: 09096927

FILING DATE: 06/12/1998

PATENT NUMBER:

ISSUE DATE:

STEVEN POST, EXAMINER  
ASSIGNMENT DIVISION  
OFFICE OF PUBLIC RECORDS

08-13-1998

Docket No. 33661-A/JFW/EMW

FORM PTO-1595 (Substitute)

(Rev. 8-96)



To the Honorable Commission

100791652

COVER SHEET

Y

DEPARTMENT OF COMMERCE

Patent and Trademark Office

is attached original documents or copy thereof.

## 1. Name of conveying party(ies):

Stewart Shuman and  
JoAnn Sekiguchi

Additional name(s) of conveying party(ies) attached?

☐ Yes ☒ No

## 3. Nature of Conveyance:

- ☒ Assignment ☐ Merger  
☐ Security Agreement ☐ Change of Name  
☐ Other \_\_\_\_\_

Execution Date(s): 07/1/98 and 07/08/98

## 2. Name and address of receiving party(ies):

Sloan-Kettering Institute for  
Name: Cancer Research

Internal Address: \_\_\_\_\_

Street Address: 1275 York Avenue

City/State/Zip: New York, New York 10021, U.S.A.

Additional name(s) & address(es) attached? ☐ Yes ☒ No

## 4. Application number(s) or patent number(s): If this document is being filed together with a new application, the execution date(s) of the application is(are):

A. Patent Application No.(s) 09/096,927,  
filed June 12, 1998

B. Patent No.(s) \_\_\_\_\_

Additional numbers attached? ☐ Yes ☒ No

## 5. Name and address of party to whom correspondence concerning document should be mailed:

Name: John P. White

Internal Address: \_\_\_\_\_

Street Address: Cooper & Dunham LLP  
1185 Avenue of the Americas

City/State/Zip: New York, New York 10036

## 6. Total number of applications and patents involved: 1

7. Total fee (37 CFR \$3.41): \$ 40.00

☐ Enclosed☒ Authorized to be charged to deposit account

## 8. Deposit account number:

03-3125

DO NOT USE THIS SPACE

## 9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Albert Wai-Kit Chan

Name of Person Signing

Signature

Reg. No. 36,479

August 6, 1998

Date

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231.

Albert Wai-Kit Chan

Reg. No. 36,479

Date

Total Number of pages including cover sheet, attachments and document: 4

OMB No. 0651-0011 (exp. 4/94)

Mail documents to be recorded with required cover sheet information to:

08/12/1998 DNGUYEN 00000064 033125 09096927

Commissioner of Patents and Trademarks

Box Assignments

Washington, D.C. 20231

01 FC:581

40.00 CH

11/10/98 8-6-98



## Assignment

*In consideration of One Dollar (\$1.00). and other good and valuable considerations, the receipt of which is hereby acknowledged. We, the undersigned.*

Stewart Shuman and JoAnn Sekiguchi residing at 504 East 63rd Street, New York, New York 10021, U.S.A. and 97 Elm Street, Massachusetts 02178, U.S.A., respectively.

*Hereby sell, assign and transfer to Sloan-Kettering Institute for Cancer Research  
a corporation of the State of New York  
having a place of business at 1275 York Avenue  
in the County of New York and State of New York 10021, U.S.A.  
its successors, assigns and legal representatives, the entire right, title and interest for all  
countries, in and to any and all inventions which are disclosed and claimed, and any and all  
inventions which are disclosed but not claimed, in the application for United States Patent,  
which has been executed by the undersigned on July 1, 1998 and July 8, 1998 and is entitled*

COVALENT JOINING OF DNA STRANDS TO RNA STRANDS CATALYZED BY VACCINIA  
TOPOISOMERASE

(U.S. Serial No. 09/096,927, filed June 12, 1998, claiming benefit of  
U.S. Provisional No. 60/049,405, filed June 12, 1997.)

*and in and to said application and all divisional, continuing, substitute, renewal, reissue, and all  
other applications for U.S. Letters Patent or other related property rights in any and all  
foreign countries which have been or shall be filed on any of said inventions disclosed in said  
application; and in and to all original and reissued patents or related foreign documents which  
have been or shall be issued on said inventions;*

*Authorize and request the Commissioner of Patents of the United States to issue to said  
Assignee, the corporation above named, their successors, assigns and legal representatives, in  
accordance with this assignment, any and all United States Letters Patent on said inventions  
or any of them disclosed in said application;*

Agree that said Assignee may apply for and receive foreign Letters Patent or rights of any other kind for said inventions, or any of them; and may claim, in applications for said foreign Letters Patent or other rights, the priority of the aforesaid United States patent application under the provisions of the International Convention of 1883 and later modifications thereof, under the Patent Cooperation Treaty, under the European Patent Convention or under any other available international agreement; and that, when requested, without charge to, but at the expense of, said Assignee, its successors, assigns and legal representatives, to carry out in good faith the intent and purpose of this assignment, the undersigned or the undersigned's executors or administrators will, for the United States and all foreign countries, execute all divisional, continuing, substitute, renewal, reissue, and all other patent applications or other documents on any and all said inventions; execute all rightful oaths, assignments, powers of attorney and other papers; communicate to said Assignee, its successors, assigns and representatives, all facts known and documents available to the undersigned relating to said inventions and the history thereof; testify in all legal proceedings; and generally do everything possible which said Assignee, its successors, assigns or representatives shall consider desirable for aiding in securing, maintaining and enforcing proper patent protection for said inventions and for vesting title to said inventions and all applications for patents or related foreign rights and all patents on said inventions, in said Assignee, its successors, assigns and legal representatives; and

**Covenant** with said Assignee, its successors, assigns and legal representatives that no assignment, grant, mortgage, license or other agreement affecting the rights and property herein conveyed has been made to others by the undersigned, and that full right to convey the same as herein expressed is possessed by the undersigned.

Date: July 1, 1998

Witness: Vera Hineck

Vera Hineck

45 Brooklyn Avenue

West Hempstead, NY 11552

Stewart Shuman [I.S.]  
Stewart Shuman

Date: \_\_\_\_\_ 19

Witness: \_\_\_\_\_

\_\_\_\_\_  
JoAnn Sekiguchi

[I.S.]

Agree that said Assignee may apply for and receive foreign Letters Patent or rights of any other kind for said inventions, or any of them; and may claim, in applications for said foreign Letters Patent or other rights, the priority of the aforesaid United States patent application under the provisions of the International Convention of 1883 and later modifications thereof, under the Patent Cooperation Treaty, under the European Patent Convention or under any other available international agreement; and that, when requested, without charge to, but at the expense of, said Assignee, its successors, assigns and legal representatives, to carry out in good faith the intent and purpose of this assignment, the undersigned or the undersigned's executors or administrators will, for the United States and all foreign countries, execute all divisional, continuing, substitute, renewal, reissue, and all other patent applications or other documents on any and all said inventions; execute all rightful oaths, assignments, powers of attorney and other papers; communicate to said Assignee, its successors, assigns and representatives, all facts known and documents available to the undersigned relating to said inventions and the history thereof; testify in all legal proceedings; and generally do everything possible which said Assignee, its successors, assigns or representatives shall consider desirable for aiding in securing, maintaining and enforcing proper patent protection for said inventions and for vesting title to said inventions and all applications for patents or related foreign rights and all patents on said inventions, in said Assignee, its successors, assigns and legal representatives; and

**Covenant** with said Assignee, its successors, assigns and legal representatives that no assignment, grant, mortgage, license or other agreement affecting the rights and property herein conveyed has been made to others by the undersigned, and that full right to convey the same as herein expressed is possessed by the undersigned.

Date: \_\_\_\_\_ 19

\_\_\_\_\_  
Stewart Shuman

[L.S.]

Witness: \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

Date: 7/15/98 19

Witness: Karen M. Frank

Karen M. Frank

33 Forest St.

Wakefield, MA 01880

JoAnn Sekiguchi [L.S.]  
JoAnn Sekiguchi

ASSIGNMENT  
BY

Stewart Shuman  
Joann Sekiguchi

TO

SLOAN-KETTERING INSTITUTE FOR  
CANCER RESEARCH

Application for letters Patent of  
the United States for:  
COVALENT JOINING OF DNA STRANDS TO  
RNA STRANDS CATALYZED BY VACCINIA  
TOPOISOMERASE

Attorney for X John P. White

Cooper & Dunham LLP

1185 Avenue of the Americas

New York, N.Y. 10036

212-278-0400